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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANJAY PUJARE, ROBERT DEUEL, NICHOLAS RYAN,
MANUEL BENITEZ, and DAVID LIN

Appeal 2009-000027
Application 09/826,607
Technology Center 2400

Decided:¹ June 24, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-52. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on June 11, 2009.

We AFFIRM.

THE INVENTION

Appellants' invention relates generally to the streaming of computer program object code across a network in a computer environment. More particularly, the invention relates to streaming and execution of existing applications across a network of servers streaming computer program object code and other related data to clients in a computer environment. (Spec. 1).

Claim 1 is illustrative:

1. A process for converting a conventionally coded computer application program into a data set suitable for streamed delivery across a network from a server to a client in a computer environment, comprising the steps of:

providing installation monitoring means for monitoring an installation process of said conventionally coded application program on a local computer system;

wherein said installation monitoring means gathers modification information including system registry modifications that said installation process makes to certain file paths in a system registry of said local computer system;

parameterizing said system registry modifications by replacing certain of said file paths in said system registry modifications with parameters that are recognizable by said client to re-direct requests for reading said system registry to a registry spoofer; and

providing data set creation means for processing said modification information for converting said application program into a data set suitable for deceiving said client into allowing streaming of bits of said data set over said network to said client such that said application program is capable of beginning execution on said client prior to downloading all of said application program.

PRIOR ART

The Examiner relies upon the following references as evidence in support of the obviousness rejections:

Kumar	US 6,343,287 B1	Jan. 29, 2002
Schmeidler	US 6,374,402 B1	Apr. 16, 2002
Cheng	US 6,457,076 B1	Sep. 24, 2002
Eylon	US 6,574,618 B2	Jun. 3, 2003

THE REJECTIONS

1. The Examiner rejected claims 1-6, 8-19, 21-32, 34-45, and 47-52 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eylon, Kumar, and Schmeidler.
2. The Examiner rejected claims 7, 20, 33, and 46 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eylon, Kumar, Schmeidler, and Cheng.

GROUPING OF CLAIMS

Appellants argue independent claims 1, 14, and 27 as a group. (App. Br. 12-13). We will, therefore, treat claims 14 and 27 as standing or falling with representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue independent claim 40 and dependent claims 2, 3, 5, 6, 7, 8, and 13 separately (App. Br. 13-16).

APPELLANTS' CONTENTIONS

Appellants contend that the Eylon, Kumar, and Cheng references may not be prior art. (*See* App. Br. 9 and 28). Assuming *arguendo* that the cited combination references are prior art, Appellants further contend that certain claim limitations are not disclosed by the Examiner's proffered combination of cited references (App. Br. 12-16). We have enumerated the specific claim limitations argued by Appellants in the ISSUES section *infra*. We address Appellants' specific arguments for each issue in our ANALYSIS section *infra*.

EXAMINER'S RESPONSE

In the "Response to Arguments" section of the Answer, the Examiner disputes Appellants' contention that the references relied upon are not prior art (Ans. 11-12). The Examiner also maintains that the limitations argued by Appellants are taught or suggested by the cited combination of references. (Ans. 12-19).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown the Examiner erred in relying upon the Eylon, Kumar, and Cheng references as prior art? (*See* App. Br. 9 and 28).
2. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests conversion of a conventionally coded application into a streaming application? (*See* claims 1 and 40).
3. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests installation monitoring means (as in recited claim 1), or monitoring an installation process and gathering modification information (as recited in claim 40)?
4. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests parameterizing system registry modifications (*See* claims 1 and 40).

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the Examiner's proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

THE EYLON REFERENCE

1. Eylon teaches that "[p]rior to streaming an application, the application files are divided into small segments called streamlets." (Col. 5, ll. 53-54).
2. Eylon teaches "[a]ccording to one aspect of the invention, a virtual file system ("VFS") 160 is provided to store and organize received program streamlets and present an appearance to the operating system 140 that all of the application files are locally present. The VFS 160 resides on a

local storage device, such as the client's hard drive. Some or all of the VFS 160 can alternatively be retained in system memory.” (Col. 8, ll. 14-19).

3. Eylon teaches

The VFS 160, through the FSD driver 150, is configured to appear to the operating system as a local virtual file system which can be accessed by the operating system in the same manner as other data storage devices 190. When a streaming application is launched, it is configured to indicate the VFS 160 as the source for application files. Thus, from the operating system point of view, the application appears to be present on a local drive. However, unlike a conventional local file system 190, such as a hard disk or CD-ROM accessed through a conventional device driver 180, the VFS 160 does not need to (and generally will not) contain complete copies of the various required application files. Instead, only those portions of the various data files which have been provided to the client as streamlets are present. The data behind some files may be missing and other files may be only partially present.

(Col. 8, ll. 23-39).

4. Eylon teaches “[i]n configurations where the server autonomously streams data to the client, it is useful in making the selection of which streamlets to forward for the server to monitor the state of the client executed streamed application.” (Col. 12, l. 66 through col. 13, l. 2).

ANALYSIS

At the outset, we consider Appellants' arguments in the Briefs only to the extent that such arguments are directed to claimed subject matter.

ISSUE 1

We decide the question of whether Appellants have shown the Examiner erred in relying upon the Eylon, Kumar, Schmeidler, and Cheng references as prior art (*See* App. Br. 9 and 28).

We note that the instant application on appeal has an effective filing date of April 5, 2001, and also claims the benefit of U.S. Provisional Patent Application Serial No. 60/246,384 that was filed on November 6, 2000 (Spec. 1).

We begin with Eylon, which was filed on Dec. 28, 2000, before the April 5, 2001 filing date of the instant application on appeal. Because the filing date of Eylon antedates the filing date of the instant application on appeal, we find Eylon is prior art *subject to a showing by Appellants that each of the instant claims on appeal is fully supported by common subject matter described in U.S. Provisional Patent Application Serial No. 60/246,384*, (filed on November 6, 2000). *See Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (“As we explained in *In re Oetiker*, the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.”) *See Id.* (“Once the applicant is so notified, the burden shifts to the applicant to rebut the prima facie case with evidence and/or argument.”)

Because Appellants have not provided a showing of the requisite provisional support in the Briefs, we find Appellants' argument that

“applicants *believe* that Eylon is not prior art because the filing date of Eylon is later than the effective date of the present application” to be unavailing. (App. Br. 9, emphasis added). We decline to ground our decision on Appellants’ asserted *beliefs*. We note that arguments Appellants could have made but chose not to make in the Briefs are deemed to have been waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We acknowledge that references within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). However, we find Appellants have adopted an unreasonably narrow interpretation regarding the purported field of endeavor of the instant claims, and have not convincingly addressed the Examiner’s broader findings which we adopt, as follows:

Applicant’s invention operates within the field of endeavor for the delivery of software. Steamed delivery is merely one format for the delivery of software over a communications network. All of the selected prior art references, Eylon (6,574,618), Kumar (6,343,287), Schmeidler (6,374,402) and Cheng (6,457,076), are in the same field of endeavor as Applicant’s Invention, which is the delivery and installation of software over network communications.
(Ans. 12).

Accordingly, we find Eylon (filed on Dec. 28, 2000), Kumar (filed May 19, 1999), Schmeidler (filed May 12, 1999), and Cheng (filed Sept. 13, 2000) are each available as prior art because (1), each of these references has a filing date that antedates the effective filing date of the instant application

on appeal (April 5, 2001) and (2), because Appellants have not established that each of the instant claims on appeal are entitled to the benefit of the November 6, 2000 filing date of U.S. Provisional Patent Application Serial No. 60/246,384.

ISSUE 2

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests conversion of a conventionally coded application into a streaming application (*See* claims 1 and 40).

Referring to paragraph [0072] of the Specification pointed to by Appellants in the Brief (page 19), we find Appellants have given no special definition to the claim term “conventionally coded application” (claim 1) that differs from the meaning it would otherwise possess. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). *Cf. Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (“[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.”).

Here, Appellants proffer an example of a “conventionally coded application” as “an application that has to be installed before execution,” (App. Br. 10, ¶3). However, we find claims 1 and 40 are silent regarding such argued limitations. Moreover, claim 40 is silent regarding the term “*conventionally*.” Therefore, we broadly but reasonably construe the claimed *conventionally coded application* (claim 1) as any application that is coded using any conventional technique or language.

We particularly note that Appellants appear to acknowledge that either Eylon or Schmeidler disclose a *conventionally coded* application, at least in the Background section: “It should be noted that since Eylon and Schmeidler do not disclose installation of a conventionally coded application (other than in the Background), it follows” (App. Br. 12). Eylon teaches that “[p]rior to streaming an application, the application files are divided into small segments called streamlets.” (FF 1). We note that FF 1 does not reference the “Background” section of Eylon. Given our aforementioned claim construction, we find Eylon teaches a *conventionally coded application* that is converted to a streaming application when it is divided (i.e., converted) into small segments called streamlets. We find this teaching meets the argued preamble limitations of each of independent claims 1 and 40.

ISSUE 3

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests installation monitoring means (as in recited claim 1), or monitoring an installation process and gathering modification information (as recited in claim 40).

Regarding claim 1, Appellants merely recite the language of the claim, and assert that “since Eylon and Schmeidler do not disclose installation of a conventionally coded application (other than in the Background), it follows that Eylon and Schmeidler do not disclose providing installation monitoring means for monitoring an installation for a conventionally coded application, as in claim 1. Moreover, the Background does not disclose installation monitoring means.” (App. Br. 12).

Regarding claim 40, Appellants restate this same argument on pages 13-14 of the Brief, and further assert that “[s]ince Eylon and Schmeidler do not disclose[] monitoring an installation process, it follows that Eylon and Schmeidler do not disclose gathering modification information as in claim 40.”

We begin our analysis by noting that Appellants stated during the hearing on June 11, 2009 that the “local computer system” recited in the body of claims 1 and 40 could be any computer system and did not have to be the same computer as either the client or server recited in the preamble of the claims.

We note that Eylon teaches “[a]ccording to one aspect of the invention, a virtual file system (“VFS”) 160 is provided to store and organize received program streamlets and present an appearance to the operating system 140 that all of the application files are locally present. The VFS 160 resides on a local storage device, such as the client's hard drive.” (FF 2). We note that Eylon further teaches “[s]ome or all of the VFS 160 can alternatively be retained in system memory.” (FF 2).

Because Eylon’s virtual file system (“VFS”) 160 (or system memory) *stores at least some of the streamed application streamlets that are required for execution of the streamed application at a particular time* (FF 2), we find they are part of a conventionally coded application that is at least

temporarily “installed” (i.e., stored) on Eylon’s computer system.² Further, we note Eylon expressly teaches that “[i]n configurations where the server autonomously streams data to the client, it is useful in making the selection of which streamlets to forward for the server to monitor the state of the client executed streamed application.” (FF 4, emphasis added). Therefore, based on our review of the evidence, we find Eylon at least *suggests* the argued limitations of installation monitoring means for monitoring an installation process, monitoring an installation process of an application program, and gathering modification information on modifications, as claimed. We note that the Examiner looks to the Kumar and Schmeidler references for teaching or suggesting the claimed registry modifications. (See Ans. 13-14 and 17-18).

The issue of whether Eylon’s application is “installed” appears to be the crux of the disagreement between the Appellants and the Examiner. We acknowledge that Appellants clearly do not consider Eylon’s streamed application to be an *installed* application (See e.g., App. Br. 28, “Eylon and Schmeidler are directed to streamed applications that are *streamed rather than installed*.”) (Emphasis in original). However, we broadly but reasonably construe an application as being “installed” if it is *stored for execution* in a computer system in any manner, even if the application is

² See FF 3: Eylon teaches that “the VFS 160 does not need to (and generally will not) contain complete copies of the various required application files. Instead, *only those portions of the various data files which have been provided to the client as streamlets are present*. The data behind some files may be missing and other files may be only partially present.” (Emphasis added).

only stored for execution of one application code portion at a time (*e.g.*, as application “streamlets” that are downloaded and temporarily installed for execution in a dynamic fashion as required).

Because Eylon’s virtual file system (“VFS”) 160 (or system memory) *stores* (i.e., installs for execution) *at least some of the streamed application streamlets that are required for execution of the streamed application at a particular time* (FF 2), we find Appellants’ argued limitations broadly but reasonably encompass the teachings and suggestions of Eylon (and the Examiner’s proffered combination of references) for essentially the same reasons argued by the Examiner in the Answer, and for the reasons discussed above.

ISSUE 4

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests parameterizing system registry modifications (*See* claims 1 and 40).

Appellants ground their arguments for claims 1 and 40 on the premise that since “Eylon and Schmeidler do not disclose the installation monitoring means, it follows that Eylon and Schmeidler do not disclose parameterizing system registry modifications” (App. Br. 12, last paragraph, and 14, paragraph 3).

Because we have found *supra* that at least Eylon teaches or suggests installation monitoring means, we find Appellants’ arguments unavailing. We disagree with Appellants for essentially the same reasons argued by the Examiner on pages 13-15 of the Answer.

Claims 2, 3, 5, and 6

With respect to each of claims 2, 3, 5, and 6, Appellants have: (1) merely recited the language of the claim, (2) asserted that the limitations are not taught or suggested by the combination of Eylon and Schmeidler, and (3) failed to respond to the specifics of the Examiner's rejection (which is also based on Kumar) (*see* App. Br. 15). Appellants have not provided a basis for any of their assertions. We note that a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Moreover, it is our view that Appellants have failed to comply with the requirements of 37 C.F.R. § 1.111(b) by merely reciting the language of the claim and asserting that such language is not taught by the reference. Therefore, we find Appellants' arguments are merely conclusory, and do not meet the burden of showing error in the Examiner's *prima facie* case of obviousness.

Claims 7, 8, and 13

Appellants ground their arguments for these claims on the premise that since Eylon and Schmeidler do not disclose an installation process or installation monitoring means, it follows that Eylon and Schmeidler fail to disclose a versioning table (claim 6), or providing a user interface (claim 7), or recording common configurations (claim 13). (*See* App. Br. 15-16).

Because we have found *supra* that at least Eylon teaches or suggests an installation process and installation monitoring means, we find Appellants' arguments unavailing. We disagree with Appellants for essentially the same reasons argued by the Examiner in the Answer.

Remaining claims on appeal

We have addressed independent claims 1 and 40 *supra*. Independent claims 14 and 27 fall with claim 1. Appellants have not presented any substantive arguments directed to the separate patentability of claims 4, 9-12, 15-26, 28-39, and 41-52. These claims fall with the respective independent claim from which they depend.

Combinability of the cited references

We note that the presence or absence of a reason “to combine references in an obviousness determination is a pure question of fact.” *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999)). To the extent that Appellants have challenged the combinability of the references, we have considered Appellants’ arguments (*e.g.*, see App. Br. 17, 27). However, based upon our review of the record before us, we find the Examiner has articulated a reasoning having a sufficient rational underpinning to support the legal conclusion of obviousness.

CONCLUSION

Based on the findings of facts and analysis above, Appellants have not established that the Examiner erred in rejecting claims 1-52 as being obvious over the cited prior art under 35 U.S.C. §103(a).

DECISION

The Examiner's decision rejecting claims 1-52 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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